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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,066	12/11/2003	Razvan Rentea	11251/11	9588

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EXAMINER

ASTORINO, MICHAEL C

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/734,066

Applicant(s)

RENTEA ET AL.

Examiner

Michael C. Astorino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The examiner acknowledges the amendment and remarks filed December 27, 2005.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 1, the applicant introduces the limitation, "configured to contact the skin of a user and detect one or more biofeedback signals from the skin of the user without application of an electrical signal to the user." In claim 8, the applicant introduces the limitation, "by contacting the skin of the user without introducing an electrical signal to the skin of the user." The dependent claims 9-11 are rejected as being dependent on a rejected claim.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear to the examiner how the cellular telephone has an "embedded"

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biofeedback device, when the biofeedback device and the cellular phone are disclosed as separate entities and “embedded” means *to cause to be an integral part of a surrounding whole* (Dictionary.com). The separate devices are exemplified by the illustration in figure 1 as biofeedback device (100) and cell phone (130).

The applicant has stated that the “embedded” is listed in the specification. The applicant has cited a first and second embodiment for the term embedded and it’s meaning in the claims. However, in the first embodiment the “embedded” talks about the components of the device, but the claims regarding the components are not claimed. The claims are not in light of the specification, but limitations from the specification are not read into the claims. As such the term “embedded biofeedback measuring device” is indefinite. Additionally the second embodiment does nothing to clarify the issue.

Claims 1 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicant has claimed the use of a cellular telephone in both claims. The applicant also discloses the use of a biofeedback device included in a cellular phone without applying an electrical signal to the user. The use of a cellular phone in normal operation just by operating normally applies an electrical signal as radiant energy by an electromagnetic waves. The dependent claims 9-11 are rejected as being dependent on a rejected claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5-9, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by

Iwabuchi et al. US Patent Number 6,327,495 B1.

See previous office action for details of the rejection.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Mault US Patent Number 6,478,736 B1.

See previous office action for details of the rejection.

Claim 2. A biofeedback system comprising: a biofeedback device configured to measure biofeedback signals of a user and communicate information about the biofeedback signals to a remote receiver (column 6, lines 1-30); and a cellular telephone device configured to receive the information about the biofeedback signals and produce a visual display related to the information on a display screen (column 6, lines 1-30, figures 7-12).

Claim 3. The biofeedback system of claim 2 wherein the biofeedback device and the cellular telephone device contain complementary radio communication circuits for communicating the information about the biofeedback signals (Bluetooth, column 6, lines 1-30).

Claim 4. The biofeedback system of claim 3 wherein the complementary radio communication circuits comprise Bluetooth transceivers. (column 6, lines 1-30)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Iwabuchi et al. US Patent Number 6,327,495 B1 in view of Yoo US Patent Number 6,421,560 B1. (cited by applicant)

See previous office action for details of the rejection.

Response to Arguments

Applicant's arguments filed December 20, 2005 have been fully considered but they are not persuasive. The applicant makes some valid arguments as to the failure of the prior art to the applicant's invention. However at the present time the scope of the claims are not readably interpretable by the examiner because of the 112 rejections and new matter. However, the examiner will address issues argued by the applicant.

In regards to all claims, the applicant states, on page 4, paragraph [0005], "In general, a biofeedback device is any device which detects a body condition, such as an electrical or mechanical response, and produces a usable output." The applicant states on page 7, lines 20-21, "Pedometers do not measure biofeedback from the body, but just measure movement, thus no comparison." As per the applicant's own definition a body condition includes a mechanical response. A pedometers is a gauge that approximates distance traveled on foot by registering the number of steps taken. Otherwise stated, it is a mechanical response.

In regards to claim 1, "embedded" includes those components which are integral and wired devices are integral. Also relevant for claim 8.

The applicant has not amended nor remarked on independent claim 2. The examiner still relies on Mault to reject the claim, however has given other support for the rejection, see above. The examiner does not withdraw the pervious rejection directed to different disclosure. The examiner feels the presently cited disclosure is better suited to address the applicant's remarks.

In regards to claim 3, “complementary radio communications circuits” is not defined by the applicant. Additionally the claimed limitation states, “wherein the biofeedback device and the cellular telephone device contain complementary radio communication circuits *for* communicating the information about the biofeedback signals.” The word “for” in the claim may be properly interpreted as “capable of,” and “capable of” does not require that reference actually teach the intended use of the element, but merely that the reference does not make it so it is incapable of performing the intended use. In addition the applicant argues, “In contrast, claim 1 recites ‘complementary radio communications circuits’ embedded in both the standard cellular telephone as well as the biofeedback device.” However, complementary radio communications circuits *embedded in both the standard cellular telephone as well as the biofeedback device* is not claimed. In claim 4, the applicant’s remarks are moot based on the cited disclosure of the previously applied reference. However, the examiner cited column 11, lines 24-34 in the previous action for the statement made by Mault, “The Bluetooth protocol may be used for all short range communications and data transfer described in this specification.” Not for the narrow recited limitation of the control entertainment device embodiment. “All Short range communications” include those communications between the PDA/cellular Phone (52) and the biofeedback device (10 or other sensors described in the specification including those in figure 15 and column 10, lines 1-21)

The applicant has not amended nor remarked on independent claim 5. Additionally in regards to claim 7, the applicant has argued what is “typical” but hardly what is the broadest reasonable interpretation of the claimed invention. The examiner disagrees with the applicant, and stands by his rejection.

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In regards to claim 8, the amended claim has added new matter which makes the claim indefinite. Additionally, the term embedded still makes claim interpretation difficult because the term is vague. As such the examiner maintains his rejection.

In regards to claim 10, the argument argues that the combination lacks motivation. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Yoo states the added benefit of the increased use of the medical procedure by a user when the user has been taught to use the device, see column 1, lines 26-39. A medical procedure includes the use of the biofeedback measuring device.

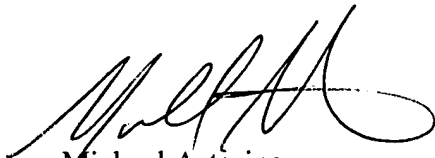
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Astorino whose telephone number is 571-272-4723. The examiner can normally be reached on Monday-Friday, 8:30AM to 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571-272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Michael Astorino', with a stylized flourish at the end.

Michael Astorino
March 18, 2006